

REMARKS

Applicants have studied the Office Action dated September 2, 2003. No new matter has been added. It is submitted that the application, as amended is in condition for allowance. By virtue of this amendment, claims 1-33 are pending. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested. In the Office Action, the Examiner:

- Objected to claims 8-10, 13 and 27 because of Informalities; and
- Rejected claims 1-33 under 35 U.S.C. § 102(e) as being anticipated by Picco (U.S. 6,029,045).

Overview of the Present Invention

Preferred embodiments of the present invention are directed to a method, computer program product and system for providing multiple sources of program and advertisement distribution in a customized fashion. The multiple sources of program content includes broadcast, cable, removable computer readable medium such as CDs, DVD, and Internet. The present invention allows the pre-storing of parts of all of the multimedia segments that are assembled together and rendered to the viewer. Using the present system, not only can advertisement be customized on a per household basis but it is also possible to tailor the content to the viewer. For example the movie "Titanic" -- the violence, mature subject matter and adult scenes are not appropriate for children. Using the present invention, certain portions (i.e. multimedia segments of the movie) are replaced depending on the viewer. This replacement relies on providing one or more alternate sources for multimedia content, which are available prior to, or concurrently with, the user's viewing. The user does not control the assembly of the playlist, but rather a provider or sponsor of the program content, such as at the cable head end, assembles the playlist. Further, the playlist indicates whether a file is to be played out synchronously. An exemplary application of this is video mail merge for advertising -- that is, a new card ad would be played out for all viewers with an audio

track tailored to a specific household. For example - - "And this week just for John Doe, this new card can be yours for \$25000."

In order to more particularly point out this of a playlist features of selecting among "multiple sources of program content" along with "a time when the multimedia segment is rendered" along with "an entry indicating if the multimedia segment is rendered as an audio overlay", the following language has been added to the independent claims, i.e., claims 1, 11, 18, and 28 as follows:

wherein the playlist is based on a user's demographics including zip code, set assembled by the program provider;

wherein the playlist contains pointers to indicate where each of the multimedia segments selected from a group of media sources consisting of broadcast stream, internet, and removable computer readable medium is located;

wherein the playlist contains a time when the multimedia segment is to be rendered; and

wherein the playlist contains an entry indicating if the multimedia segment is rendered as video with a customized audio overlay;

Support for this claim language can be found in the application as originally filed at pages 14-16 and FIG. 3.

Objections to the Claims

As noted above, the Examiner objected to claims 8-10, 13 and 27 because of informalities. Claims 8-10, 13 and 27 have been amended as suggested by the Examiner. Accordingly, the Applicants respectfully submit that the Examiner's objection has been overcome for claims 8-10, 13, and 27.

Rejection under 35 U.S.C. §102(e)

As noted above, the Examiner rejected claims 1-33 under 35 U.S.C. § 102(e) as being anticipated by Picco (U.S. 6,029,045). Independent claims 1, 11, 18, and 28 have been amended to distinguish over Picco. The Examiner at page 3 of the Office Action states, “*Regarding claim 1, Picco discloses the data transmission facility assembles and transmits individualized instructions (play-list) to each set-top box and the instructions indicate what local content should be stored and when each piece of local content should be inserted into the live data streams (column 3, lines 1-13).*” The “individualized instructions” as describe by Picco does not include instructions for selecting among “multiple sources of program content” along with “a time when the multimedia segment is rendered” along with “an entry indicating if the multimedia segment is rendered as an audio overlay”. More specifically, the “individualized instructions” as disclosed by Picco do not teach or suggest the limitations of independent claims 1, 11, 18, and 28:

wherein the playlist is based on a user's demographics assembled by the program provider;

wherein the playlist contains pointers to indicate where each of the multimedia segments selected from a group of media sources consisting of broadcast stream, internet, and removable computer readable medium is located;

wherein the playlist contains a time when the multimedia segment is to be rendered; and

wherein the playlist contains an entry indicating if the multimedia segment is rendered as video with a customized audio overlay;

Accordingly, independent claims 1, 11, 18, and 28 distinguish over Picco for at least these reasons.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims

as being anticipated by Picco.¹ The elements in independent claims 1, 11, 18, and 28 of "multiple sources of program content" along with "a time when the multimedia segment is rendered" along with "an entry indicating if the multimedia segment is rendered as an audio overlay" is not taught or disclosed by Picco. The "individualized instructions" of Picco do have a time element as the Examiner states, however, this time element is not for adding audio overlay into a multimedia segment so as to permit further customization of an advertisement to a household. The present invention enables the building of a complete custom multimedia presentation where content stored as multimedia segments is chosen from a "group of media sources consisting of broadcast stream, internet, and removable computer readable medium." The present invention enables the formation of a customized channel based on a playlist, such as news, where different multimedia segments are assembled together from different sources e.g. broadcast news on channel 2 at 7PM; the news broadcast on channel 5 at 8PM; and the newsfeed on online URL www.cnnfn.com at 10 PM and a commercial inserted with a custom audio overlay directed to a specific name in the viewing household. This type of customization using a playlist is nowhere suggested or taught by Picco. Accordingly, the present invention distinguishes over Picco for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome.

Independent claims 1, 11, 18, and 28 have been amended to distinguish over Picco. Claims 2-10, 12-17, 19-27, and 29-33 depend from claims 1, 11, 18, and 28 respectively; since dependent claims contain all the limitations of the independent claims, claims 2-10, 12-17, 19-27, and 29-33 distinguish over Picco, as well.

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Clr. 1987). "The identical invention must be shown in

CONCLUSION

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as previously amended.

In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

as complete detail as is contained in the ... claim."

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PLEASE, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

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